



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 22

James Carmichael
Miles & Stockbridge
1751 Pinnacle Drive
Suite 500
McLean, VA 22102-3833

COPY MAILED

JAN 21 2003

OFFICE OF PETITIONS

In re Gluck
Patent No. 6,142,532
Application No. 09/149,747
Filed: September 8, 1998
Issued: November 7, 2000
Attorney Docket No.

ON PETITION

This is a decision on the renewed petition under 37 CFR § 1.181(a)(3), filed December 2, 2002, invoking the supervisory authority of the Commissioner to review the refusal of the Certificate of Correction Branch to issue a Certificate of Correction. The petition will also be treated in the alternative under 37 CFR 1.182 and 37 CFR 1.183.

The petition under 37 CFR 1.181 is **dismissed**.

The petition under 37 CFR 1.182 is **dismissed**.

The petition under 37 CFR 1.183 is **dismissed**.

Facts:

On September 8, 1998, petitioner filed application no. 09/149,747. The application is a continuation of patent no. **5,803,501**, which is a continuation in part of patent no. 5,421,583, which is a continuation in part of patent no. **5,417,431**.

On November 25, 1998, the Office mailed a non-final Office action stating, "Claims 6-20 are rejected under the judicially created doctrine of double patenting over claims 1-7 of U.S. Patent No. 5,803,501."

On March 29, 1999, petitioner filed a response to the Office action which stated, "With regard to the double patenting rejection, a Terminal Disclaimer is filed herewith. It is noted that this is a fax copy from the Assignee of the present application, and the original will be forwarded for filing in this application when it is received by mail." The terminal disclaimer listed patent no. **5,417,431**.

On June 22, 1999, the Office sent an Office action stating, "The person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324." The portion of the Office action dealing with the double patenting rejection repeated some of the language from the prior Office action including, "Claims 6-20 are rejected under the judicially created doctrine of double patenting over claims 1-7 of U.S. Patent No. 5,803,501."

On August 31, 1999, petitioner replied to the prior Office action. Petitioner "Enclosed . . . an original document from the Assignee L.N.C.J. confirming the authority of the signature to the Terminal Disclaimer dated March 24, 1999 and file[d] March 25, 1999." The original document states, "The Chairman presented to the meeting a Terminal Disclaimer in respect of a certain U.S. Patent for Memorabilia Card re US Patent No. 5,417,413, and It Was Resolved that either of Mr. C.S. Hotton or Mr. P.M. Van Neste be authorised as Director to sign the Disclaimer on behalf of the company."

On January 24, 2000, petitioner filed a paper stating, "This document is submitted in response to Examiner's telephone request for an identification of the persons who signed the document filed August 26, 1999, [summarizing the minutes of a meeting]." The paper identified the persons who signed the previously submitted document.

On November 7, 2000, the application issued as patent no. 6,142,532.

On June 10, 2002, petitioner filed a request for a Certificate of Correction. The request sought in essence to withdraw the terminal disclaimer listing patent no. 5,417,431, and to substitute a terminal disclaimer listing patent no. 5,803,501.

Petitioner's request was denied by the Decisions and Certificate of Corrections Branch on July 25, 2002.

On September 9, 2002, petitioner filed a petition under 37 CFR § 1.181(a)(3), invoking the supervisory authority of the Commissioner to review the refusal of the Certificate of Correction Branch to issue a Certificate of Correction. The petition was also filed in the alternative under 37 CFR 1.182 and 37 CFR 1.183.

The petition under 37 CFR 1.181 was dismissed based on the contention that a Certificate of Correction may not enlarge the scope of the claims.¹ The decision stated that petitioner was requesting a change which would alter the term of the patent. The decision stated, "If petitioner's request was granted, the patent's 'claims would be able to be sued upon for a longer period than would the claims of the original patent. Therefore, the vertical scope, as opposed to the horizontal scope (where the subject matter is enlarged), would be enlarged.'" ² Therefore, since the requested Certificate of Correction would enlarge the scope of the claims, the petition was not granted.

Regarding the petitions under 37 CFR 1.182 and 1.183, the decision stated,

As for the petition under 37 CFR 1.182, the mechanisms provided by Congress to correct a patent are certificate of correction, reissue, and reexamination. The Office will not unilaterally create new mechanisms to correct "mistakes" subsequent to the issuance of an application as a patent. A standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing). Absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other

¹ In re Arnott, 19 USPQ2d 1049 (Comm'r Pat. 1991) ("Where a proposed correction involves a change in claim scope, the reissue statute is controlling, not the provisions of law governing Certificates of Correction.") *citing*, Eagle Iron Works v. McLanahan Corporation, 429 F.2d 1375, 1383, 166 USPQ 225, 231 (3d Cir. 1970).)

² Ex Parte Anthony, 230 USPQ 467 (Bd. App. 1982), *aff'd*, No. 84-1357 (Fed. Cir. June 14, 1985).

remedies for such situation.³ Since Congress has provided a specific scheme for the correction of patents, the creation of other schemes (*e.g.*, 37 CFR 1.182 or 1.183) for the correction of patents would be inconsistent with the patent statutes. Thus, the Commissioner's authority to correct patents is limited to that specified in the statutory scheme set forth by Congress.

As for the petition under 37 CFR 1.183, the Office may waive the requirements of a rule, but the Office lacks the authority of discretion to relax any requirement imposed by statute.⁴ The Office may not circumvent the statutory schemes created by Congress to correct patents.

A discussion of the role of reissue and reexamination applications to withdraw or nullify a terminal disclaimer can be found at MPEP 1490(B).

The instant petition should not be interpreted to preclude petitioner from submitting a terminal disclaimer for patent no. 5,803,501 in addition to (not to replace) the terminal disclaimer currently in force. Petitioner *may* file a petition under 37 CFR 1.182 to enter the additional disclaimer if, out of an abundance of caution, petitioner wishes to have the additional terminal disclaimer entered into the file. The submission of the additional disclaimer would not need to be accompanied by a request for a Certificate of Correction since the terminal disclaimer would simply be entered into the file which is open to public inspection.

The instant petition requests reconsideration of the prior petition. Petitioner argues that the requested change will not enlarge the term of the patent. Specifically, patent no. 5,417,431 was filed on November 3, 1993, and the patent issued on May 23, 1995. The statutory date of expiration will be November 3, 2013. Patent no. 5,803,501 was filed on December 15, 1994, claiming priority to patent no. 5,417,431, and issued on September 8, 1998. The statutory date of expiration for patent no. 5,803,501 will be September 8, 2015. The patent which is the subject of the instant petition was filed on September 8, 1998, claiming priority to patent no. 5,417,431. The instant patent issued on November 7, 2000. The statutory date of expiration for the instant patent is November 3, 2013.

If the petition is not granted, the instant patent's term will end⁵ on the earlier of:

- (a) November 3, 2013, or
- (b) the date the instant patent and patent no. 5,417,431 cease to be commonly owned.

If the petition is granted, the instant patent's term will end on the earlier of:

- (a) November 3, 2013, or
- (b) the date the instant patent and patent no. 5,803,501 cease to be commonly owned.

³ See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode").

⁴ See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998) (the PTO cannot by rule or waiver of the rules fashion remedies that contravene 35 USC sections 112 and 120), A.F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir. 1977) (As an executive agency, PTO must follow strict provisions of statute).

⁵ Use of the phrase "term will end" should not be construed literally since loss of common ownership does not render the patent expired but only unenforceable during the period the patents are not commonly owned.

The instant petition argues that the standard of review of the Certificate of Corrections Branch should not be an "arbitrary and capricious" standard.

The instant petition argues that the prior decision's citation of In re Arnott⁶ is incorrect since that case dealt with a change to the language of a claim, and not the term of a patent.

Statute:

35 U.S.C. 255 states,

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director **may**, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. (Emphasis added)

Opinion:

The petition under 37 CFR 1.181:

A certificate of correction is improper because a mistake does not appear in the patent.

The patent states, "This patent is subject to a terminal disclaimer." Petitioner does not argue that this statement is incorrect. Instead, petitioner desires to correct an error within the prosecution history. A certificate of correction may not be used to correct the substance of a terminal disclaimer. 35 USC 255 requires a "mistake" to appear "in a patent." Petitioner has failed to establish that "in a patent" includes papers in the file which are not part of the printed patent.

Even if a certificate of correction could be used to correct a terminal disclaimer, the Office does not have the authority under 35 USC 255 to correct the instant mistake.

The Office **may** issue a certificate of correction if petitioner demonstrates:

- (1) a mistake of a clerical or typographical nature,
- (2) or a mistake of minor character.

As to (1), a certificate of correction which results in the broadening of a claim may be issued only under specific circumstances.

Petitioner's requested change *may* result in the broadening of the scope of the claims. When the term of a patent is extended, the scope of the claims is enlarged.⁷ The requested change would enlarge the term the patent could be enforced should the instant patent and patent no. 5,417,431 cease to be commonly owned prior to November 3, 2013. Petitioner has failed to prove that the patents cannot cease to be commonly owned during the future years.

⁶ The citation at issue is In re Arnott, 19 USPQ2d 1049 (Comm'r Pat. 1991) ("Where a proposed correction involves a change in claim scope, the reissue statute is controlling, not the provisions of law governing Certificates of Correction.") *citing*, Eagle Iron Works v. McLanahan Corporation, 429 F.2d 1375, 1383, 166 USPQ 225, 231 (3d Cir. 1970).)

⁷ Ex Parte Anthony, 230 USPQ 467 (Bd. App. 1982), *aff'd*, No. 84-1357 (Fed. Cir. June 14, 1985) (the patent's "claims would be able to be sued upon for a longer period than would the claims of the original patent. Therefore, the vertical scope, as opposed to the horizontal scope (where the subject matter is enlarged), would be enlarged.")

Since the change may result in a change to the scope of the claims, petitioner must establish:

- (a) the existence of an error,
- (b) the existence of the error is "clearly evident from the specification, drawings, and prosecution history," and
- (c) the method by which the error should be corrected is clearly evident.⁸

As to (a), petitioner contends that the wrong number was listed on the terminal disclaimer due to a typographical error on the part of petitioner.

As to (b), "a clerical or typographical error should be manifest from the contents of the file of the patent sought to be corrected." Superior Fireplace Co. v. Majestic Prods. Co., 270 F.3d 1358, 1372, 60 USPQ2d 1668 (Fed. Cir. 2001) (citing In re Arnott, 19 USPQ2d 1049 (Comm'r Pat. 1991)). The exact identity of the error is not clearly evident or manifest from the contents of the file. The patents at issue are not unrelated. The application is a continuation of patent no. 5,803,501, which is a continuation in part of patent no. 5,421,583, which is a continuation in part of patent no. 5,417,431. The instant facts do not involve two drastically different patents where only one of the patents involve subject matter included in the instant patent. The record does not *clearly* indicate that the examiner may not have considered the current terminal disclaimer to obviate the double patenting rejection even though the terminal disclaimer did not cite the patent listed in the rejection. Petitioner has not proven that the examiner failed to notice the discrepancy in patent numbers prior to allowance and that, had the examiner noticed the discrepancy, he would not have mailed a Notice of Allowance. It is possible that a full review and reexamination of all the relevant claims would indicate the exact nature of the error and the method by which the error should be corrected. However, certificates of correction are not appropriate if granting the certificate would first involve reexamination of the claims.

As to (c), the method by which the error should be corrected is not immediately and clearly evident. Assuming a typographical error occurred, a review of the record fails to clearly indicate whether the error was made by petitioner or the examiner. The patent number listed on the terminal disclaimer and other papers may be incorrect or the patent number listed in the rejections may be incorrect. A review of the record does not clearly indicate that the terminal disclaimer should not have been entered and that a terminal disclaimer for patent no. 5,803,501 should have been required. On August 31, 1999, petitioner submitted minutes of a meeting stating, "The Chairman presented to the meeting a Terminal Disclaimer in respect of a certain U.S. Patent for Memorabilia Card re US Patent No. 5,417,413, and It Was Resolved that either of Mr. C.S. Hotton or Mr. P.M. Van Neste be authorised as Director to sign the Disclaimer on behalf of the company." The August 31, 1999 paper indicates that patent no. 5,417,413 was discussed and that permission to sign a terminal disclaimer for patent no. 5,417,413 was granted. An assumption that patent no. 5,417,413, is incorrect is an assumption that several individuals erred in believing the patent no. should be 5,417,413. The record does not indicate that the party signing the terminal disclaimer, or the assignee, ever intended to list patent no. 5,803,501 on the terminal disclaimer. It is possible that a full review and reexamination of all the relevant claims would indicate the exact nature of the error and the method by which the error should be corrected. However, certificates of correction are not appropriate if granting the certificate would first involve reexamination of the claims.

Petitioner has failed to establish a specific error which is clearly evident upon a review of the record. Therefore, the error is not a clerical or typographical error which may be corrected under 35 USC 255.

⁸ Superior Fireplace Co. v. Majestic Prods. Co., 270 F.3d 1358, 1370-1371, 60 USPQ2d 1668 (Fed. Cir. 2001).

Petitioner has failed to establish that the error is a mistake of a minor character. A mistake which would broaden the scope of a claim is not a mistake of a minor character.⁹ Since the requested change might result in the broadening of the scope of the claims, the mistake is not of a minor character.

A change to a patent under 35 USC 255 which might result in a change to the term of a patent will not be permitted if the change is not due to a clearly evident error and the method by which the error should be corrected is not clearly evident. The importance of public notice as to the scope and term of a patent should not be ignored. Notices of disclaimers are published in the Official Gazette and are attached to the printed copies of the specification. The risk of unanticipated broadening resides with the patentee who has availed itself of the benefits of the patent system and not on the public who are entitled to rely on the public record.¹⁰

Even if a certificate of correction was a permissible method to correct terminal disclaimers, and even if petitioner could establish the error was a mistake of a clerical or typographical nature or a mistake of minor character, the Office retains the discretion to not issue the certificate of correction.

35 USC 255 states the Office may issue a certificate of correction if certain requirements are met. The statute does not state the Office shall issue such a certificate and is therefore not mandatory but is instead permissive.

MPEP 1490 clearly states that the policy of the Office is not to allow the revocation of a terminal disclaimer after a patent issues. Issuance of the requested certificate of correction would, in essence, revoke the terminal disclaimer which pertains to patent no. 5,417,431. Patentee knew, or should have known, of the stringent statutory and regulatory provisions which severely limit the scope of USPTO treatment of an alleged mistake in an issued patent, as well as the long-established USPTO policy on the treatment of recorded terminal disclaimers after issuance as set forth in MPEP 1490.¹¹ In response to MPEP 1490, petitioner should have exercised diligence in ensuring the contents of the patent's file were correct. Petitioner has failed to discuss why the error occurred despite the exercise of due care or to establish that due care was used prior to issuance to ensure no mistakes were present. Petitioner is reminded that equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with

To grant the petition might result in a denial of the right of some or all other individuals to make, use, import or sell the product, during a period of the patent's term. As stated in Walker Process Equipment, Inc. v. Food Machinery & Chemical Corp., 382 U.S. 172, 175 (1965), "A patent by its very nature is affected with a public interest . . . [It] is an exception to the general rule against monopolies and to the right to access to a free and open market." (quoting Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co., 324 U.S. 806, 816 (1945)). The Supreme Court has stated, "[W]e must consider petitioner's claim in light of this Nation's historical antipathy to monopoly [footnote omitted] and of repeated congressional efforts to preserve and foster competition. As this Court recently said without dissent: 'In rewarding useful invention, the 'rights and welfare of the community must be fairly dealt with and effectually guarded.'

⁹ Superior Fireplace Co. v. Majestic Prods. Co., 270 F.3d 1358, 1375, 60 USPQ2d 1668 (Fed. Cir. 2001).

¹⁰ See Superior Fireplace Co. v. Majestic Prods. Co., 270 F.3d 1358, 1373, 60 USPQ2d 1668 (Fed. Cir. 2001) (citing Southwest Software, Inc. v. Harlequin, Inc., 226 F.3d 1280, 1296, 56 USPQ 1161 (Fed. Cir. 2000)).

¹¹ The MPEP has no binding force on the courts, but it commands notice as to official interpretation of statutes and regulations with which it does not conflict. Patent attorneys, examiners, and the public commonly rely on the MPEP as a guide in procedural matters.

Kendall v. Winsor, 21 How. 322, 329 (1859). ‘To that end the prerequisites to obtaining a patent are strictly observed, and when the patent issued the limitations on its exercise are equally strictly enforced.’ Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 230 (1964).” Deepsouth Packing Co. v. Laitram Corp., 406 U.S. 518, 530-531 (1972).

As a general rule, public policy does not favor the restoration to the owner of a patent something which has been freely dedicated to the public.¹²

The Office notes that if all three patents discussed are commonly owned during the entire pendency of the instant patent, then granting the petition will have no substantive effect on the rights of the public. However, petitioner has failed to prove that all three patents discussed will remain commonly owned during the entire pendency of the instant patent. In addition, if granting the petition would have no substantive effect on petitioner’s rights or the public’s rights, then the record fails to discuss why the Office need exercise its discretion and grant the requested relief.

Summary of petition under 37 CFR 1.181:

Petitioner has failed to prove that a certificate of correction may be used to correct the contents of a terminal disclaimer and to effectively revoke and replace the terminal disclaimer. Petitioner has failed to prove the existence of a mistake of a clerical or typographical nature, or a mistake of minor character, within the meaning of 35 USC 255. Assuming the Office had the authority and discretion to grant the requested certificate of correction, petitioner has failed to prove that the Office should exercise such discretion to grant the requested relief.

In order to fully address the merits of the petition, the Office will address petitioner’s contentions that the standard of review of the Certificate of Corrections Branch should not be an “arbitrary and capricious” standard and the contention that the prior decision’s citation of In re Arnott¹³ is incorrect since that case dealt with a change to the language of a claim, and not the term of a patent. Since a de novo review of the action of the Certificate of Corrections Branch indicates that petitioner is not entitled to a certificate of correction, it is unnecessary at this time to determine the extent to which portions of the Office may choose to defer to other portions of the Office. As to In re Arnott, since the prior decision involved the issuance of a certificate of correction to make a change which might affect the scope of the claims, the Office does not agree that it is incorrect to cite a case which discusses the use of a certificate of correction to make a change which would affect the scope of one or more claims. Although not mentioned by petitioner, it is noted by the Office that the prior decision was incorrect in so far as the decision conveyed that a certificate of correction may never enlarge the scope of the claims.

The petitions under 37 CFR 1.182 and 37 CFR 1.183:

As for the petition under 37 CFR 1.182, the mechanisms provided by Congress to correct a patent are certificate of correction, reissue, and reexamination. The Office will not unilaterally create new mechanisms to correct “mistakes” subsequent to the issuance of an application as a patent. A standard principle of statutory construction is: *expressio unius est exclusio alterius* (the mention of one thing implies exclusion of another thing). Absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute

¹² See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935).

¹³ The citation at issue is In re Arnott, 19 USPQ2d 1049 (Comm’r Pat. 1991) (“Where a proposed correction involves a change in claim scope, the reissue statute is controlling, not the provisions of law governing Certificates of Correction.”) *citing*, Eagle Iron Works v. McLanahan Corporation, 429 F.2d 1375, 1383, 166 USPQ 225, 231 (3d Cir. 1970).)

is deemed to exclude other remedies for such situation.¹⁴ Since Congress has provided a specific scheme for the correction of patents, the creation of other schemes (*e.g.*, 37 CFR 1.182 or 1.183) for the correction of patents would be inconsistent with the patent statutes. Thus, the Commissioner's authority to correct patents is limited to that specified in the statutory scheme set forth by Congress. In addition, as noted previously, even if the Office had discretion to grant the relief requested, petitioner has failed to establish that such discretion should be exercised to grant the petition.

As for the petition under 37 CFR 1.183, the Office may waive the requirements of a rule, but the Office lacks the authority of discretion to relax any requirement imposed by statute.¹⁵ The Office may not circumvent the statutory schemes created by Congress to correct patents. In addition, as noted previously, even if the Office had discretion to grant the relief requested, petitioner has failed to establish that such discretion should be exercised to grant the petition.

A discussion of the role of reissue and reexamination applications to withdraw or nullify a terminal disclaimer can be found at MPEP 1490(B).

The instant petition should not be interpreted to preclude petitioner from submitting a terminal disclaimer for patent no. 5,803,501 in addition to (not to replace) the terminal disclaimer currently in force. Petitioner *may* file a petition under 37 CFR 1.182 to enter the additional disclaimer if, out of an abundance of caution, petitioner wishes to have the additional terminal disclaimer entered into the file. The submission of the additional disclaimer would not need to be accompanied by a request for a Certificate of Correction since the terminal disclaimer would simply be entered into the file which is open to public inspection.

Decision

The prior decision regarding issuance of a certificate of correction for the above-identified patent has been reconsidered. For the reasons herein and stated in the previous decision, a certificate of correction can not be issued under 35 USC 254 or 255. For the reasons stated in this decision, the petitions under 37 CFR 1.182 and 1.183 are dismissed.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

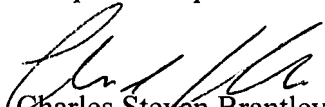
The previous petition authorized the Office to charge fees to deposit account no. 12-2475 and was signed by Samuel Stone. However, the fee could not be charged because Samuel Stone is not an authorized user for deposit account no. 12-2475. Therefore, \$260 will now be charged to deposit account no. 50-1165.

¹⁴ See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode").

¹⁵ See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998) (the PTO cannot by rule or waiver of the rules fashion remedies that contravene 35 USC sections 112 and 120), A.F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir. 1977) (As an executive agency, PTO must follow strict provisions of statute).

The file is being forwarded to Files Repository.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.



Charles Steven Brantley
Petitions Attorney
Office of Petitions